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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/676,909

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Harald Kropshofer

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PATENT LAW DEPARTMENT
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EXAMINER

VANDERVEGT, FRANCOIS P

ART UNIT

PAPER NUMBER

1644

MAIL DATE

DELIVERY MODE

12/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/676,909	Applicant(s) KROPSHOFFER ET AL.	
	Examiner F. Pierre VanderVegt	Art Unit 1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-33 is/are pending in the application.
- 4a) Of the above claim(s) 28-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 17-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20070830</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim 16 has been canceled.

Claims 1-15 and 17-33 are currently pending.

Election/Restrictions

1. **Claims 28-33 stand withdrawn** from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on October 6, 2006.

Claim 15 has been REJOINED with the invention of Group I.

Accordingly, **claims 1-15 and 17-27 are the subject of examination** in the present Office Action and only to the extent that they read upon MHC class II peptides.

In view of Applicant's amendments filed July 17, only the following grounds of rejection are maintained.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-15 and 17-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 13, 14 and 27 are ambiguous and unclear in the recitation of "isolating antigenic peptides in femtomolar amounts." The term "femtomolar" does not specify any specific amount, but is rather a term that can be associated with a concentration of a substance in a carrier.

Applicant's arguments filed July 17, 2008 have been fully considered but they are not persuasive.

Applicant asserts that the term is definite and that this was acknowledged by the Office by the previous removal of the same ground of rejection. The ground of rejection had indeed been previously been removed, but further review of the claims necessitated the reinstatement of the ground of rejection. The Examiner regrets the inconvenience caused by the removal of the ground and its return. However, the term "femtomolar" is inconsistent with the recitation of an amount of a product as the expression is

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related to concentration of a substance in a carrier, not an actual amount of the substance. It is suggested that Applicant amend the claim to recite the range of “about 16 to 320 femtomoles” in the preamble and remove the recitations of “femtomolar amount.”

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-2, and 7-12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kalbacher et al (J. Chromatography [1991] 548:343-350; C34 on form PTO-1449 filed 12/8/2006).

It was previously stated: “Kalbacher teaches the isolation of antigenic peptides from human HLA-DR MHC class II molecules in femtomolar amounts (page 348, last two paragraphs and Figure 4 in particular). Kalbacher teaches the elution of the peptides from the complexes using “diluted” acid and the identification of the peptides via chromatography.

As stated in paragraph 3 supra, the term “femtomolar” is indicative of a concentration of a substance in a carrier, rather than a measurement of a quantity. While Kalbacher does not specifically teach the concentration of the eluate, it would be well within the purview of the artisan to elute antigenic peptides from MHC class II receptors at a wide range of concentrations.”

Applicant asserts that the claimed method is non-obvious over the method of Kalbacher because Kalbacher requires two elutions while the instant invention only requires a single elution. Applicant argues that Kalbacher therefore teaches away from the claimed invention. Applicant’s arguments are not persuasive. There is nothing in the claims that limit practice of the claimed invention to a single elution step. The claim merely recites that the “method comprises” [line 2] “(c) eluting the associated antigenic peptides from the peptide receptors.” As the claim is written in an open format, step (c) reads upon a limitless number of elutions, requiring only that the elution be performed, not how many times the step

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can be performed. Accordingly, the two elution steps of Kalbacher still fall within the scope of the claim and do not “teach away.” While the “claimed invention only requires one elution step,” the claimed invention is not limited to only one elution step.

Conclusion

4. No claim is allowed.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Pierre VanderVegt whose telephone number is (571)272-0852. The examiner can normally be reached on M-Th 6:30-4:00 and Alternate Fridays 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Eileen O’Hara can be reached on (571) 272-0878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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F. Pierre VanderVegt, Ph.D. /PV/

Patent Examiner

October 27, 2008

/Eileen B. O'Hara/

Supervisory Patent Examiner

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